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12/31/2003

First Named Inventor

Timothy L. Hoopman

Art Unit

3711

Examiner Name

Layno, Benjamin

Attorney Docket Number

03001

**ENCLOSURES (Check all that apply)**☐

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Fee Attached

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Amendment/Reply

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After Final

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Affidavits/declaration(s)

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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

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Signature

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William R. Berggren

Date

June 21, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Timothy L. Hoopman

Title: Cards for Columnar Card Games

Filed: December 31, 2003

Examiner: Benjamin Layno

Ser. No. 10 / 749,601

Art Unit: 3711

Mail Stop Appeal Brief - Patents  
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APPEAL BRIEF

Dear Sir:

This is an Appeal Brief for an appeal of the final rejection of the claims of the above application that was mailed from the United States Patent and Trademark Office on January 23, 2006. A Notice of Appeal was mailed on April 21, 2006 with a Pre-Appeal Brief Request for Review. The Pre-Appeal Brief was found unpersuasive of gross errors and an Applicant was invited to submit an Appeal Brief. It is Applicant's position that there are still clear errors in the Examiner's rejections and that examiner has omitted one or more essential elements needed for prima facie rejections under either 102(b) or 103.

Please find the following::

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### **Appeal Brief**

The final office action was mailed on January 23, 2006. Examiner states that Claims 1-17 were rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103 as being anticipated by or obvious over *Stauff*. Examiner's sole prior art reference to support his position is *Stauff*, D181,884. Examiner's case law reliance is *Ex parte Breslow*, 192 USPQ 431, (PTOBA, 1975) and *In re Gulack*, 217 USPQ 401, (CAFC 1983).

### **Issues**

Examiner argues that all claims are rejected as either anticipated or obvious over prior art for at least one of four reasons: (1) the prior art is "capable" of lessening columnar length, (2) "horizontally proximate" is a relative term that can be broadly interpreted to include the prior art, (3) elements of the claimed invention that differ from the prior art are un-patentable printable subject matter, and (4) there is no novel or unobvious functional relationship between the printed matter and the substrate of the invention. It is the Applicant's position that the Examiner is incorrect in each of these arguments for rejection. Further, it is the Applicant's position that Examiner has omitted at least one necessary element needed for a prima facie rejection.

### **Background**

The facts of the case are as follows. Applicant's invention is for a pack of playing cards for use in columnar games like bridge or solitaire that result in shorter lengths of columns. This is well described in the background, specification and Rule 132 Affidavit. Specifically, the invention is defined in claim 1 of the utility patent application as a pack of playing cards comprising cards having indicia in judicious placement to lessen both precision of vertical columnar alignment and columnar length over that obtainable with a previously known pack of playing cards. Claims 2-7 claim embodiments with more detailed structures where first indicia lie in corners and second indicia lie horizontally proximate to first indicia with the same reading orientation. Some embodiments of the invention described in Claims 2-7 are shown in Fig. 4-6. Claims 8-17 claim structures where (1) second indicia are in a region extends between two corner first indicia but not including a position proximate the secondary corners, (2) second indicia are in the same

reading orientation as horizontally aligned first indicia, and (3) the cards have a central graphic with a split mirror image. Some embodiments of the invention described in Claims 8-17 are shown in Fig. 1, 3.

*Stauff* is a design patent that claims cards having an appearance shown in the figures. The figures show cards having first indicia, numbers, located in diagonally opposed primary corners and diagonally opposed secondary corners. The cards further have second indicia, suits vertically proximate primary indicia and second indicia horizontally displaced midway between first indicia. The indicia appear to be oriented in a manner to permit cards laid in rows from left to right or in columns from bottom to top, neither formation used in columnar games such as bridge or solitaire.

A supportable rejection under 35 U.S.C. 102(b) requires that one reference shows all elements of the rejected claims. A supportable rejection under 35 U.S.C. 103 requires that all elements of the claimed invention must be suggested or taught by one or more references

### Rejection 1 - "Capable"

Examiner states in his last office action of 1-23-2006 that *Stauff* "discloses a pack of playing cards having many of the features recited in claims 1-17. "The first indicia (numerical value) in the primary corners and secondary corners are clearly horizontally aligned with the second indicia (suit) in a region bordering the top edge and bottom edge. The judicious placement of the second indicia (suit)" ... "makes the playing cards **capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known packs of playing cards."

*Stauff* being **capable** of permitting less precise and shorter columnar arrangements is insufficient for a rejection under 35 U.S.C. 102(b) or under 35 U.S.C. 103. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d.628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A prima facie case of an obviousness rejection requires that the examiner present evidence that teaches or suggests the claimed invention. This can done only by showing some objective teaching in the prior art or that

knowledge generally available to one of ordinary skill in the art would lead that individual” to make that change.” *Stauff* is a design patent with no suggestion of changing the claimed designs to render the upper second indicia in a right-reading orientation or of using numbers as second indicia and suits as first indicia, an embodiment of the claimed invention. *Stauff* may be suitable for vertical row alignment but not columnar alignment.

*Stauff* was what Applicant meant when stated in claim 1 “lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known packs of playing cards.” *Stauff* was disclosed to the USPTO by Applicant in an Information Disclosure Statement submitted with the application. The precision of columnar alignment and columnar length referred to games like Solitaire and Bridge and similar games where cards are laid out in descending manner in columns as taught in the Specification. In addition, *Stauff* was not similar to the more structured embodiments of Claims 2-7 or 8-17. *Stauff* did not disclose or suggest second indicia horizontally proximate to first indicia, required of claims 2-7 (see discussion regarding “horizontally proximate” below). Also, *Stauff* did not disclose or suggest structures having the three elements of: (1) second indicia in a region extends between two corner first indicia but not including a position proximate the secondary corners (2) second indicia that are in the same reading orientation as horizontally aligned first indicia and (3) a central graphic with a split mirror image. These last two features provide a sense of familiarity that is important in some situations such as, for example, contract bridge tournaments. In other situations, orientation of second indicia is still important. In embodiments where second indicia are numbers, right reading numbers, such as “6” resemble upside-down reading “9.” Thus not all elements are taught or suggested by *Stauff* and both the anticipation and obviousness rejections are improper and should be withdrawn.

### **Rejection 2 - Broad Interpretation of “Horizontally Proximate”**

“The examiner takes the position that the term ‘horizontally proximate’ is a relative term that is open to broad interpretation” to allow *Stauff* to anticipate the invention or make it obvious. Thus, although claims 2-7 and Fig 4-6 claim and teach embodiments where the second indicia are proximate to first indicia, Examiner takes the position that the broad interpretation of “horizontally proximate” allows *Stauff* to anticipate the invention or make it obvious.

Claim language is primarily read in light of the specification. *Phillips v. AWH Corp.*, 415 F.3d, 1303 (CAFC, 2005). “The first paragraph of section 112 of the Patent Act, 35 U.S.C. § 112, states that the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same . . . . The second paragraph of section 112 provides that the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Those two paragraphs of section 112 frame the issue of claim interpretation for us. The second paragraph requires us to look to the language of the claims to determine what ‘the applicant regards as his invention.’ On the other hand, the first paragraph requires that the specification describe the invention set forth in the claims.” The court states that other means of interpretation, such as general dictionaries, are secondary sources to be used where the specification is unclear or silent.

Applicant’s specification uses proximate and adjacent interchangeably. The specification refers to second indicia in various embodiments claimed specifically in Claim 2-7 as being horizontally “adjacent” to first indicia on page 9, line 14; page 10, line 3; page 12, line 6; page 18, line 9; and page 19, line 12. Some of these embodiments are shown in Fig 4-6. The specification refers to the second indicia for an embodiment specifically claimed in Claim 9-17 as being a **region** between a point adjacent to the first indicia and a point about midway between primary and secondary corners. Claims 9-17 and Fig 1, 3 claim and teach embodiments where the top **region** containing the second indicia (not the second indicia) borders the top edge and extends to the right of the right-reading first indicia but not within a **region** proximate to the secondary corner. Nothing in the claims or specification permits a broad interpretation that is made by the examiner. Thus not all elements are taught or suggested for Claims 2-7 that require the element “horizontally proximate” and this anticipation or obviousness rejection is not proper and should be withdrawn for those claims.

### **Rejection 3 - Un-Patentable Printable Subject Matter**

The Examiner also states that *Stauff* differs in (1) right-reading orientation and upside-down-reading orientation of second indicia [as suits], (2) an absence of second indicia proximately

below or above first indicia in secondary corners [claimed in dependent claims 3, 5, 13 & 16], and (3) face cards not having split orientation central graphics that seem similar whether seen right-side up or upside down. However, Examiner holds that these differences reside in the meaning and information conveyed by printed matter and are not considered patentable, citing *In re Breslow*, 192 USPQ 431 (PTOBA, 1975).

The PTOBA in *In re Breslow* held that *Breslow* was unpatentable over *Mitchell*, US 3,565,437 because any differences between the two games resided in the meaning and information conveyed by printed matter and that such differences were not considered patentable differences. The PTOBA found no patentable differences in the *Breslow* structure.

However, holdings by the Court of Appeals, Federal Circuit (CAFC) provide clarification that distinguishes Applicant's invention from *Breslow*. The Court of Customs and Patent Appeals (CCPA) stated in *In re Miller*, 164 USPQ 46 (CCPA 1969) that while printed matter by itself is not patentable subject matter because it is non-statutory, there is no reason for ignoring it when the claim is directed to a combination. In *In re Miller* there was a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating ratio. Its successor court, the Court of Appeals, Federal Circuit, (CAFC) clarified the issue in *In re Gulack*, 217USPQ 405 (CAFC, 1983) by saying that "differences between an invention and prior art cited against it cannot be ignored merely because these differences reside in the content of printed mater," "the claim must be read as a whole," and "where the printed matter is not functionally related to the substrate the printed matter will not distinguish the invention from the prior art in terms of patentability." Examiner appeared to recognize this in part by offering Rejections 1 and 2. However, he was unwilling to see the functional relationship between the differences in the printed matter elements that he acknowledged were there with the manufactured card substrate to view the printed matter differences as patentable distinctive elements.

In *In re Gulack*, the CAFC held that a functional relationship did exist. It found that "a functional relationship of the precise type found by the CCPA in *In re Miller* – to size or type of substrate – is not required." "What is required is the existence of **differences** between the appealed claims and the prior art sufficient to establish patentability. The bare presence or

absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

Thus the issue is whether there is a novel or unobvious functional relationship between the printed matter differences and the substrate. If there are then the printed matter differences are valid elements on which to analyze patentability. Applicant's position is that there is a functional relationship and that the printed matter differences are patentably distinct differences to *Stauff*. Because the printed matter is part of a combination and should be evaluated for patentability, this rejection is not proper and should be withdrawn. This will be addressed in the next section.

#### **Rejection 4 - No Novel or Unobvious Functional Relationship Between the Printed Matter and the Substrate of the Invention**

Examiner states that, alternatively, the invention is obvious in light of the prior art because there is no novel or unobvious functional relationship between the printed matter and the substrate of the invention. Examiner does not expand on this argument other than to suggest that *Stauff* is capable of being modified to anticipate Applicant's invention and that horizontally proximate, when broadly interpreted, anticipates Applicant's invention. Both of these arguments have been addressed above.

CAFC in *In re Gulack* further states that "the critical question is whether there exists a new and unobvious functional relationship between the printed matter and the substrate." In *In re Gulack*, the new and unobvious relationship was a sequence of numbers having a repetitive order where the numbers were arranged in a continuous loop on a band, e.g., a hat band. Mitchell merely disclosed a display of numbers.

Similarly, Applicant's invention has a new and unobvious functional relationship between the printed elements and the substrates. That combination permits columns of shorter length and columns with less precise columnar alignment than obtained with known decks of playing cards; a result with significant benefits in games like Solitaire when played on small tables as those in an airplane and hospital trays, and Bridge, particularly Contract Bridge where tables are



numerous and smaller than normal (see Specification pages 1-6, 11, 21). Right-reading orientation is essential to solve the problems stated in the Background of the Specification where indicia that are upside-down can be misleading, e.g., “6” & “9” where an embodiment of the invention has second indicia as numbers and the bottom of a heart with the top of a diamond, where an embodiment uses traditional suits as second indicia. Split central graphics provide the card a familiar appearance that is desirable when used for competitive Contract Bridge tournaments (Claim 8 & Specification p 7-8, 17). Also, second indicia horizontally proximate or adjacent to first indicia permit even less precise alignment of columns in the games mentioned while still permitting ready viewing of the values of the cards.

Claim 1 states that the invention is “a pack of playing cards comprising cards having indicia in judicious placement to lessen both precision of **vertical** columnar alignment and columnar length over that obtainable with a previously known pack of playing cards – **including Stauff**. Stauff neither recognizes the problems solved by Applicant’s invention nor offers nor suggests any improvement of playing cards to lessen precision or length over that disclosed, for example, in Fig 1B of the application. As Examiner noted, *Stauff* teaches a second indicia in the first position having an **upside-down-reading** orientation. This would not solve the problem stated by Applicant. Some indicia, such as heart and spades could be confused in a columnar arrangement if different colors were not used. Laying the cards in a column from bottom to top is not an accepted method of playing known card games such as, for example, Solitaire or Bridge. Even in games where it is acceptable, *Stauff* teaches two first indicia horizontally aligned with a second indicia where one is in a right reading orientation and the other is in an upside-down reading orientation; not suitable for games having vertical columns as part of their play but fine for games having horizontally aligned rows as part of their play. In columnar games, such a difference in orientation of first indicia could be confusing where first indicia are numbers such as “6” or “9” during the pressure of tournament play.

“If the differences between the prior art and the claimed invention is limited to descriptive material on a substrate, office personnel must determine whether the material is functional descriptive material or nonfunctional descriptive material as described in **MPEP 2106 IV.B.1(a) & IV.B.1(b)**. “Office personnel should determine whether the descriptive material is being

claimed as part of an otherwise statutory manufacture. In such case, the claim remains statutory irrespective of the fact that the descriptive material is included in the claim. In contrast, non-descriptive material is that which cannot exhibit any functional interrelationship with the performance of a manufacture.” **MPEP 2106 VI**. While this is written primarily for software patent applications, the guidance is relevant here also.

Applicant’s position is that the descriptive material in the claims is functional. A claimed manufacture combined with descriptive elements that permit a manufacture’s functionality to be realized (1) defines structural and functional interrelationships between the manufacture and the descriptive elements and (2) is thus statutory. In Applicant’s case, the printed matter elements have a functional relationship with the article of manufacture, the pack of playing cards. As both stated and claimed, the printed matter elements permit the playing cards to be able to be less precisely vertically aligned and aligned in columns having less length. The advantages of this interrelationship are described through out the specification and include, for example, solutions to the stated needs for (1) a pack of cards to play games that involve displaying cards arranged in at least one column where playing area is limited such as, for example, some variations of Solitaire, and (2) a pack to play games that involves displaying some cards in at least one column and displaying others in a fanned arrangement such as, for example, Bridge. The solutions offered by Applicant’s invention result in stated benefits of play, some of which are (1) increased convenience and (2) the ability to play with less frustration in more cramped environments. This is particularly true for competitive Contract Bridge tournaments.

In Applicant’s case, the descriptive elements interrelate with the manufacture (the playing cards in the pack) to permit the playing cards to be used in columnar games with less precision of both **vertical** columnar alignment and shorter columnar length over that obtainable with a previously known pack of playing cards. Column length differences are illustrated in Applicant’s CFR §1.132 Affidavit of June 8, 2005 that is in the record. This functional interrelationship permits the ability of playing known games but in confined areas not previously possible or possible but only with great difficulty that can cause both physical and mental anxiety. Functional descriptive material is a patentable limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103.

A rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (CAFC, 1999). *Stauff* is a design patent claiming what is depicted in the figures. It offers no teaching or suggestion of how to achieve shorter columnar length, particularly in games such as Solitaire or Bridge, or what advantages may be offered under what circumstances. One can surmise that *Stauff* cards are useful in games having horizontally aligned rows but that is a guess. Examiner has offered no additional references to suggest or teach the differences of Applicant's invention that permit shorter and less precisely aligned columns. For reasons stated above, Applicant believes that these differences are patentable distinctive elements because there is a functional relationship between the judicious placement of indicia and the playing cards. *In re Gulack* had the novel result that the sequence of numbers displayed in an infinite array represented solutions to a class of algorithms in as novel and unobvious manner. Similarly, Applicant's judicious placement of indicia on each playing card of a pack of cards permits the novel and unobvious display of the cards in columnar alignment where the columns are advantageously shorter and require less precise alignment than *Stauff* or others known to the art when the application was filed. Thus, because there is a novel and unobvious functional relationship between the printed matter differences and the substrate of the invention, the differences are patentable distinctive elements that are not taught or suggested by *Stauff*, and this rejection is not proper and should be withdrawn

### Conclusions

Because of the above remarks, Applicant respectfully requests that the rejections be withdrawn and present application be allowed.

Customer Number 44977

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Respectfully submitted,

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